

## REMARKS

Entry of the foregoing amendments, and reexamination and reconsideration of the subject application, pursuant to and consistent with 37 C.F.R. §1.104 and §1.112, and in light of the following remarks, are respectfully requested.

Claims 10-14 have been amended; new claims 15-27 have been added; claims 10-27 are now pending.

Attached hereto is a marked version of the claims to show changes made by the current amendment. The attached page is captioned **"VERSION WITH MARKINGS TO SHOW CHANGES"**

### RESTRICTION (Office Action of March 19, 2001)

The Office Action of March 2001 states that claims 10-27 are newly submitted and are independent or distinct from the invention originally filed. The Office Action further asserts that, since the application has received an action on the merits for the originally presented claims, there has been a constructive election by original presentation. However, the Office Action has failed to point out what and how the "newly submitted" claims are "independent or distinct" from the invention originally claimed. Additionally, the Office Action has misstated the facts in addressing claims 10-27 as "newly submitted." Claims 10-14 are NOT "newly submitted", but simply amended. Furthermore, claims 10-14 have been amended in response to the Office

Action of August 31, 2000, in which the claims were rejected under 35 U.S.C. 112, second paragraph, which alleged that lines 1-4 of claim 10, were vague and indefinite. Applicant wishes to point out that the amendment of claims 10-14 was nothing more than a compliance with the instructions of the rejection.

Specifically, claim 10 was amended to simply remove the alleged vague and indefinite language of lines 1-4 with simpler terminology. In satisfying the requirement of particularly pointing out and distinctly claiming the subject matter which applicant regards as the invention, applicant simply reorganized the language to resemble a more traditional preamble, and claims 11-14 were amended accordingly. Claims 15-27, the actual "newly submitted claims", are simply variations of claims 10-14, in both apparatus and method recitations.

Further, Applicant would note that MPEP 803 requires that restriction is only proper where the inventions are independent/distinct and there is a serious burden on the examiner. "If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." The Office Action has failed to establish a prima facie case that there is a serious burden on the examiner. As a matter of fact, the Office Action of August 31, 2000, would actually lead one to believe the exact opposite, as clearly shown by the prior art cited by the Examiner.

The March 2001 Office Action alleges that the "newly submitted claims" are independent or distinct from those originally filed, yet the most relevant reference (Sato et al.) cited by the Examiner is directed to an electronic device with electromagnetic

interference suppressing.

Accordingly, applicant respectfully requests examination of all of the claims presented herein and withdrawal of the Restriction Requirement in its entirety.

**REJECTION (Office Action of August 31, 2000)**

Claims 10-14 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter of the invention, which rejection is respectfully traversed. Specifically, the Examiner has objected to lines 1-4 of Claim 10. Claims 10-14 are amended herein to clarify the subject matter of the invention.

Claims 10-14 have been rejected under 35 U.S.C. §102(a) as being anticipated by, or in the alternative, under 35 U.S.C. §103(a) as being obvious over Goto et al., which rejection is respectfully traversed. While it is the Examiner's opinion that the claimed invention is an obvious variation, the Examiner has failed to point out the teaching in Goto on which the claims allegedly read. Further, the Examiner has arbitrarily labeled the dependent claims as conventional without the slightest explanation of how such a conclusion was reached. The rejection is arbitrarily dismissing claimed structural limitations without any evidence to support the rejection. The rejection has failed to establish a prima facie case of obviousness by the failure to produce prior art. Section 1.104 of the Rules requires the examiner to cite the best references at his/her command and to be complete in explaining rejections other than those related to form. Further, the use of a single reference to show obviousness is

improper: there must be some evidence from the reference or other objective source, or evidence provided through an affidavit from the examiner, to illuminate why the differences between the claimed invention and the cited art would have been obvious. *In re Laskowski*, 10 USPQ2d 1397 (Fed. Cir. 1989); *In re Grabiak*, 226 USPQ 870, 872 (Fed. Cir. 1984); 37 C.F.R. §1.104(C)(2) and §1.104(d)(2). That knowledge may have been within the province of the ordinary artisan does not in and of itself make it so, absent clear and convincing evidence of such knowledge. See *C.R. Bard, Inc. v. M3 Sys., Inc.*, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998), *cert. den.* 1998 S. Ct. 1804 (1999); *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 297-98, 227 USPQ 657, 667 (Fed. Cir. 1985). The range of sources available for evidence of a suggestion, teaching, or motivation to modify a reference, whether from the prior art references themselves, one of ordinary skill, or from the nature of the problem, does not diminish the requirement for presenting actual evidence; and the actual evidence must be clear and particular. *C.R. Bard; In re Dembiczak*, 50 USPQ2D 1614, 1617 (Fed. Cir. 1999). Therefore, unless the showing on which the rejection is based is clear and particular, the suggestion to modify the reference would appear to be hindsight reconstruction based on the rejected claim. *W.L. Gore and Assoc., Inc. v. Garlock, Inc.*, 220 USPQ 303, 312-13 (Fed. Cir. 1983), *cert. den.*, 469 U.S. 851 (1984).

Claims 10-14, as amended, and new claims 15-27 recite a combination of an electronic device and an electromagnetic interference suppressing device, and a method for suppressing magnetic waves in such devices. Goto is clearly directed to a magnetic recording medium, and so the medium must be in motion relative to some

electronic and/or magnetic device that generates magnetic waves. The claims of the present invention recite a static combination of the composite magnetic body and the electronic device, in which no movement is required.

In accordance with the above discussions, it should be clear that neither Goto et al., nor the rest of the prior art of record, which were not specifically cited in formulating the rejection, taken alone or in combination, disclose or suggest the claimed invention. Additionally it should be clear that the Examiner has not established a prima facie case of obviousness and has used hindsight in the attempt. Hindsight cannot be used to establish a prima facie case of obviousness. *In re Fritch*, 23 USPQ2d 1780 (CAFC 1992).

In light of the foregoing, the application is now believed to be in proper form for allowance of all claims. Reconsideration and allowance of the claims is respectfully solicited.

CERTIFICATE OF MAILING OR TRANSMISSION - 37 CFR 1.8

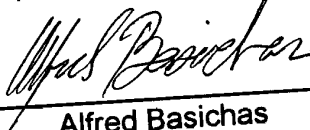
I hereby certify that I have a reasonable basis that this paper, along with any referred to above, (i) are being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to Commissioner of Patents and Trademarks, Washington, D.C. 20231, or (ii) are being transmitted to the U.S. Patent & Trademark Office in accordance with 37 CFR § 1.6(d).

DATE: April 9, 2001

NAME: Anthony Avant

SIGNATURE: Anthony Avant

Respectfully submitted,

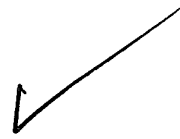


Alfred Basichas  
Reg. No. 38,771

Hopgood, Calimafde,  
Judlowe & Mondolino LLP  
60 East 42nd Street  
New York, New York 10165  
212-551-5000 ext.4081  
Fax 212-949-2795

Dated: April 9, 2001

VERSION WITH MARKINGS TO SHOW CHANGES



10. (Amended) An electronic device [A] comprising:  
    an [composite] electromagnetic interference suppressing article for [use  
with an electromagnetic device for suppressing article for use with an electronic  
device for] suppressing electromagnetic interference [of said deice] due to  
external and/or internal presence of electromagnetic waves, [said body] being  
comprised of soft magnetic powder dispersed through an organic binding agent  
and also including a heat conductive powder dispersed therethrough, for  
improving the thermal conductivity of said electromagnetic interference  
suppressing body during use thereof in association with said electronic device.
11. (Amended) The electronic device [composite magnetic body] of claim 10,  
wherein said heat conductive powder is at least one selected from the group  
consisting of alumina ( $\text{Al}_2\text{O}_3$ ), aluminum nitride (AlN), cubic boron nitride (BN)  
and silicon carbide (SiC) [(Sic)].
12. (Amendment) The electronic device [composite magnetic body] of claim 11,  
wherein [characterized in that] said organic binding agent is a thermoplastic  
resin having a glass transition temperature of not less than about 120°C.

13. (Amended) The electronic device [composite magnetic body as in] of claim 12, wherein said organic binding agent is at least one of thermoplastic polyamide and a liquid crystal polymer.
14. (Amended) The electronic device of claim 13, wherein said [An] electromagnetic interference suppressing [body as in any one of claims 10 to 13] article is in the form of a sheet[s], for use in contact with [said] [electronic device] components to control the temperature thereof during use of said electronic device.